

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 15-24** are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must entail the use of a specific machine or transformation of an article which must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Parker v. Flook*, 437 U.S. 584, 590 (1978). There is no machine claimed, according to Claim 15, which performs anything other than insignificant extra-solution activity of capturing or receiving or performs any processing activities. Moreover, while the claimed process contains physical steps (identifying, providing), it does not involve transforming an article into a different state or thing. Therefore, Applicants' claim is not drawn to patent-eligible subject matter under § 101. Claim 15 recites "system", however it appears that this is a typographical error that was intended to be --method-- (in view of the claim language) and will be treated as such for further consideration of the merits.

Claim Rejections - 35 USC § 112, Second Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 11** recites the limitation "the scoring system" in line 8. There is insufficient antecedent basis for this limitation in the claim.
5. **Claims 15-24** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. Claim 15 claims a system, however, there is no structure incorporating the steps provided. The claimed subject matter appears to be presented as steps in a method.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-14 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Pendergrass (United States Patent 4,400,017).**
8. In regards to **Claims 1 and 29**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system comprising:

- a) at least one plurality of pre-assigned fields, (Fig. 1, *pre-assigned fields are shown on right side (i.e. "budget category")*) and
- b) at least one page organizer system; (Column 2, lines 40-43, *category tabs shows a page organizer system*)

As far as the particular non-functional descriptive material to describe/label/name types of data (sports, competition, etc.) and to describe what the steps are adapted for, it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

9. In regards to **Claims 2**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system wherein the data comprises input (Fig. 1, *shows fields for inputting data*)

In addition to the above rejection, Examiner informs Applicant that the claim language comprises merely non-functional descriptive material and is therefore accorded no patentable weight. For example, the material used to describe the types of data input (i.e. scores from a judge) is deemed merely intended usage of the claim.

10. In regards to **Claims 3 and 14**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system wherein said at least one page organizer system comprises bound paper pages comprising said at least one plurality of pre-assigned fields. (Fig. 1 and Column 1, lines 32-34)

11. In regards to **Claim 4**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system wherein said bound paper pages comprise single views. (Fig. 5)

As far as the particular non-functional descriptive material to describe/label/name types of data (tournament, etc.), it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

12. In regards to **Claims 5-10**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system wherein said at least one pre-assigned field comprises information (Fig. 1, *shows fields for inputting data*)

In addition to the above rejection, Examiner informs Applicant that the claim language comprises merely non-functional descriptive material and is therefore accorded no patentable weight. For example, the material used to describe the types of data input (i.e. scoring data, identification data, etc.) is deemed merely intended usage of the claim.

13. In regards to **Claim 11**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system further comprising:

- a) at least one indicia element; (Column 4, line 56)
- c) at least one explanation (Column 1, lines 64-68, *shows instructions contained in a book*)

The phrase "at least one explanation of the scoring system... plurality of individual-sports tournaments" has been deemed non-functional descriptive material and therefore given no patentable weight.

As far as the particular non-functional descriptive material to describe/label/name types of data (sports, competition, etc.), it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

14. In regards to **Claims 12 and 13**, Pendergrass discloses:

The claim language has been deemed merely non-functional descriptive material and therefore given no patentable weight.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. **Claims 15-18, 20-25, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergrass.**

18. In regards to **Claims 15 and 25**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system comprising:

a) identifying at least one area; (Column 1, lines 16-17, *identification of area to keep records for (monthly budget)*)

b) providing a plurality of logbooks, each comprising

i) at least one plurality of pre-assigned fields, (Fig. 1, *pre-assigned fields are shown on right side (i.e. "budget category")*) and

ii) at least one page organizer system; (Column 2, lines 40-43, *category tabs shows a page organizer system*)

Pendergrass does not explicitly disclose marketing or selling to buyers.

However, marketing or selling to buyers is old and well known to those of ordinary skill in the art, and official notice to that effect is hereby taken. For example, marketing or selling to buyers is often used in order to increase profitability.

As far as the particular non-functional descriptive material to describe/label/name types of data (sports, competition, etc.) and to describe what the steps are adapted for, it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

19. In regards to **Claim 16**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system wherein the data comprises input (Fig. 1, *shows fields for inputting data*)

In addition to the above rejection, Examiner informs Applicant that the claim language comprises merely non-functional descriptive material and is therefore accorded no patentable weight. For example, the material used to describe the types of data input (i.e. scores from a judge) is deemed merely intended usage of the claim.

20. In regards to **Claim 17**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system wherein such at least one plurality of pre-assigned fields comprise at least four such pre-assigned fields (Fig. 5, *shows at least four fields*)

As far as the particular non-functional descriptive material to describe/label/name types of fields to select from (tournament identification, personal points awarded, etc.), it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

21. In regards to **Claim 18**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system further comprising the steps of:

a) identifying at least one method; (Column 1, lines 64-68, *shows instructions contained in a book*)

b) providing at least one explanation of such at least one method; (Column 1, lines 64-68, *shows instructions contained in a book*) and

c) making such at least one explanation a part of each such logbook. (Column 1, lines 64-68, *shows instructions contained in a book*)

As far as the particular non-functional descriptive material to describe/label/name types of method/instructions (scoring, etc.), it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

22. In regards to **Claim 20**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system further comprising the steps of:

- a) providing printed such logbooks comprising a plurality of pages; (X and Fig. 10)
- b) providing, relating to essentially each such logbook, a swivel binding system permitting essentially each such page, when bound, to swivel; (X and Fig. 10) and
- c) binding such pages with such swivel binding system; (X and Fig. 10)
- d) wherein such at least one page organizer system permits such pages, when bound, to comprise single views relating to each of such plurality of tournaments. (X, Fig. 5, and Fig. 10)

23. In regards to **Claim 21**, Pendergrass discloses:

A page-based personal individual-sport tournaments logbook system further comprising: at least one indicia element; (Column 4, line 56)

As far as the particular non-functional descriptive material to describe/label/name types of data (sports, competition, etc.), it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

24. In regards to **Claim 22**, Pendergrass discloses all of the above limitations.

Pendergrass does not explicitly disclose offering a discount.

However, the offering of a discount is old and well known to those of ordinary skill in the art, and official notice to that effect is hereby taken. For example, discounts are often offered in order to attract customers or to reward loyal customers.

As far as the particular non-functional descriptive material to describe/label/name types buyers (fundraising, etc.), it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

25. In regards to **Claims 23, 24, 27, and 28**, Pendergrass discloses:

The claim language has been deemed merely non-functional descriptive material and therefore given no patentable weight.

26. **Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergrass in view of Conquest et al. (Pub. No. US 2003/0004737 A1) (hereafter referred to as Conquest).**

27. In regards to **Claims 19 and 26**, Pendergrass discloses all of the above limitations, however, Pendergrass does not explicitly disclose using buyer information to solicit orders, however, Conquest teaches:

A page-based personal individual-sport tournaments logbook system further comprising the steps of:

- a) collecting contact information from such at least one buyer; ([0003]) and
- b) contacting such at least one buyer to solicit orders. ([0003])

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Pendergrass so as to have included the using buyer information to solicit orders taught by Conquest in order to increase sales and

profitability by proactively attempting to build a customer base, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

As far as the particular non-functional descriptive material to describe/label/name types of products (logbooks...tournament season, etc.), it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. S./
Examiner, Art Unit 3629
February 26, 2009

/JOHN G WEISS/
Supervisory Patent Examiner, Art Unit 3629